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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/738,455      | 12/13/2000  | Jackie Zhanhong Wu   | PRPL3012            | 9743             |

23488 7590 07/28/2005

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| EXAMINER |
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SCHUBERT, KEVIN R

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| ART UNIT | PAPER NUMBER |
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2137

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/738,455

Applicant(s)

WU ET AL.

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11082004</u>  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

Claims 8 and 12 have been considered.

***Claim Rejections - 35 USC § 112***

5 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10 Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "wherein said server system establishes a user account identification on said client system" is indefinite. It is unclear whether the establishment is actually done on the client system or whether the server system simply makes an establishment (recognizes a user account) from a user account  
15 identification residing on a client system. The examiner believes the latter to be the case. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness  
20 rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.  
25 Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus, U.S. Patent No. 6,490,601.

30

As per claim 8, the applicant describes a server system, operable in connection with a central repository of confidential user data, to support the selective distribution of confidential user-information to

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authorized partner sites on behalf of users of client computer systems, which have specific confidential user data requirements comprising the following limitations which are met by Markus:

a) a connection to a database storing confidential user data within a user account and wherein datums of confidential user data are selectable based on an account identification and server datum

5 identifications (Col 5, lines 29-44);

b) a computer system, coupleable to a communications network and, through said connection, to said database, said computer system being responsive to a network request received from a partner site relative to a client computer system, wherein said network request provides said account identification and said server datum identifications, wherein said server datum identifications have a mapped

10 relationship to the confidential user-information requirements of said partner site with respect to said user account, which is expressed as partner datum identifications, and wherein said computer system supports the determination of said mapped relationship for said partner site and provides for the generation and distribution of a mapped relationship definition to said partner site packaged to be sent as part of said network request in response to a single click on said partner site, wherein said mapped  
15 relationship definition implements said mapped relationship in a form evaluateable by said server system upon receipt as part of said network request, to enable said server system to provide a network response to said partner site containing datums of confidential user-information corresponding to said partner datum identifications, wherein said partner datum identifications and corresponding datums of confidential user-information are exclusive of executable code required to be executed by said client computer system  
20 (Col 7, line 41 to Col 8, line 5; Col 3, line 38 to Col 4, line 8);

c) a mapping processor, coupled to receive said mapped relationship definition, that implements combinatorial and logical functions to autonomously convert server datums to partner datums through a process defined by said mapped relationship definition (Col 15, lines 20-53);

Markus discloses a system which meets all the limitations of the above claim except for the  
25 limitation "wherein said partner datum identifications and corresponding datums of confidential user-information are exclusive of executable code required to be executed by said client computer system". In Markus' system, the response set of first user information includes user information and shippable code

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(Col 11, lines 2-14). The shippable code is transported with the user information and used to complete form fields associated with the user information. Thus, Markus' does not disclose sending the datums of confidential user-information exclusive of executable code because Markus' system sends the confidential user-information with executable code as part of a package.

5           However, Markus does disclose in the Background of the Invention section that a method known as the "transactor method" is similar to Markus' instant invention and relies on only sending user information **not** executable code. As disclosed by Markus, "Another method for assisting a user in filling out an electronic form document is referred to as the "transactor" method... This method differs from the wallet method in that the user is not required to download or install any software onto his or her computer" (Col 3, lines 38-44). Instead of receiving user information and executable code as taught by Markus in his system, the user receives only user information. Fig 2 is an illustration of the "transactor" method in which user information (241 of Fig 2) is received instead of user information and shippable code (324 of Fig 3A) as is the case in Markus' system.

15           It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of the prior art "transactor" method in Markus' system because sending only the user information reduces needed bandwidth for communication between the repository and the user. For example, this system would be optimal in situations where bandwidth is limited or expensive.

20           As per claim 12, the applicant describes the server system of claim 8, which is met by Markus, with the following limitation which is also met by Markus:

          Wherein said computer system is coupleable through said communications network to said client system operated by a user, wherein said server system establishes a user account identification on said client system, and wherein said client system autonomously provides said user account identification to said server system in connection with said network request (Col 11, lines 39-49).

25

***Response to Arguments***

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The new drawings have been received and are accepted by the examiner. The objection to the drawings has been withdrawn.

Applicant's arguments, see Remarks, filed 7/11/05, with respect to the rejection(s) of claim(s) 8 and 12 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

### **Conclusion**

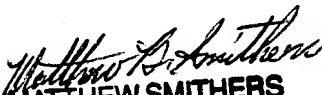
This action is made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KS

  
MATTHEW SMITHERS  
PRIMARY EXAMINER  
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